

Application No.: 09/647,748

Case No.: 54030US008

REMARKS

Claims 1-3 and 5 are pending. Claims 1 and 2 are amended. Claim 6 has been added. Support for new claim 6 can be found, for example, at page 5, lines 17-19 of the application as filed.

§ 112 Rejections

Claims 1-3 and 5 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

The Examiner has suggested a change to Claim 1. Applicant as made the requested change. This amendment is not intended to, and does not, further limit the scope of the claim.

The Examiner also objected to the phrase "comprising a material selected from the group" as open ended language. Applicant again reiterates that making this amendment to a closed Markush group is not necessary. The Examiner has not put forth any prior references that would require a definitive list of all materials in the short fibers.

In summary, Applicant submits that the rejection of claims 1-3 and 5 under 35 U.S.C. § 112, second paragraph, has been overcome, and that the rejection should be withdrawn.

§ 103 Rejections

Claims 1-3 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over NITTO DENKO CORP in view of Canary.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

The Examiner has maintained the rejection over NITTO DENKO in view of Canary because Canary teaches wood pulp with a fiber length between 2 and 5 mm. Once again, the

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Examiner ignores the limitation in Claim 1 and in Claim 2, that the short fibers comprise polyvinyl alcohol, polyamide, polyester, polyethylene, polypropylene, polyurethane, polyvinyl chloride, polyvinylidene chloride, polyacrylonitrile, rayon, and combinations thereof. Applicant has amended claims 1 and 2 to further clarify the issue for the Examiner. This amendment is not intended to, and does not, further limit the scope of the claims. Therefore, none of the references cited by the Examiner teach or suggest the short fibers in claims 1 and 2, and no *prima facie* case of obviousness has been shown.

But it is
comprising;

The rejection of claims 1-3 and 5 under 35 U.S.C. § 103(a) as being unpatentable over NITTO DENKO CORP in view of Canary has been overcome and should be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

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Date

Respectfully submitted,

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Version with markings to show amendments made:

1. (Four Times amended) A paper backing for supporting a secondary layer, [which has] said backing having a double-layer paper structure comprising a first paper layer and a second paper layer, said first paper layer and said second paper layer each being manufactured from wood pulp and short fibers, the short fibers having a length within the range of about 3 to 20 mm and the short fibers comprising a material selected from the group consisting of polyvinyl alcohol, polyamide, polyester, polyethylene, polypropylene, polyurethane, polyvinyl chloride, polyvinylidene chloride, polyacrylonitrile, rayon, and combinations thereof, wherein said first layer has a blend ratio of short fibers to wood pulp larger than the blend ratio of short fibers to pulp in the second layer.

2. (Four Times amended) An adhesive sheet comprising a paper backing and an adhesive layer provided on one of its surfaces, said paper backing having a double-layer paper structure comprising a first paper layer and a second paper layer, in which said first paper layer and said second paper layer each is manufactured from wood pulp and short fibers, the short fibers having a length within the range of about 3 to 20 mm and the short fibers comprising a material selected from the group consisting of polyvinyl alcohol, polyamide, polyester, polyethylene, polypropylene, polyurethane, polyvinyl chloride, polyvinylidene chloride, polyacrylonitrile, rayon, and combinations thereof, and said adhesive layer being provided on the surface of said first paper layer having a blend ratio of short fibers to wood pulp that is larger than the blend ratio of short fibers to wood pulp of said second paper layer.